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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,654

02/16/2001

George Brookner

770P009677-US (PAR)

2968

7590

11/16/2006

Kenyon & Kenyon LLP

1500 K Street, NW

Washington, DC 20005-1257

EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,654

Applicant(s)

BROOKNER ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) 14-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-13 and 36-42 are drawn to a postage meter, classified in class 705, subclass 60.
- II. Claims 14-35 are drawn smart card, class 902, subclass 26.

2. Claims 14 and 15 have been amended to remove the language of a device identifier that is "readable by an external system". Therefore, claims 14, 15 and [dependent claims] 16-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as postage metering, while invention II has separate utility such as a multi-functional smart card See MPEP 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-36 are withdrawn from consideration as being directed to a non-elected invention. See

37 CFR 1.142(b) and MPEP 821.03. Applicant is respectfully requested to cancel the non-elected claims in response to this office action.

3. Claims 1-13 and 36-42 have been examined.

Examiner's Comment

4. Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106, II, C; *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that an apparatus claim whose features are described in terms of actions that may or may not be done is indefinite and does not distinguish the claim from the prior art. Claim 5 is directed to a device with an adapter "*for connecting*" to said device, said adapter comprises an electrical connector "*for electrically connecting to said device*" and an interface "so that said device *can be identified*" (emphasis added). Hence, as the features of claim 5 are recited in terms of "possibility", the claim is indefinite. Claim 8 is rejected as it describes a device configured "*so as to be useful* as a postal security device", while claims 9 and 10 recite "*to be used* in a closed postal system" (emphasis added).

Claims 6 and 42 are also rejected as they depend from claim 5.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims rejected under 35 U.S.C. 102(b) as being clearly anticipated by Graves et al., U.S. Patent No. 5,309,363.

As per claims 1-10 and 36-42, Graves et al. teach a (virtual) device comprising:

- a first storage for storing funds (abstract; figure 1-item 160 and figure 4)
- an internally (e.g. circuit) stored identifier (e.g. digital data, character string) (figure 1- item 170 and figure 4; column 4, lines 1-6; column/line 6/65-7/17)
- a second storage for storing information (i.e. electronic address of the electronic host) and a communications interface (i.e. device modem) for changing said information (figure 1, item 195; column 4, lines 38-53; column/line 7/58-8/10)
- a second communications interface to provide the stored identifier to an external system (column 4, lines 43-47)
- an interface that supports communication with RS-232, IEEE 488, USB, TCP/IP, SCSI, Infrared, RF, net appliance protocol, PC, or PC bus protocols (figure 1)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al., U.S. Patent No. 5,309,363.

As per claims 11-13, 37, Graves et al. teach a device comprising a storage unit for storing an identifier (figure 1- item 170 and figure 4; column 4, lines 1-6; column/line 6/65-7/17). However, Graves et al. do not explicitly recite a corresponding indicia stored on the body of the device. It has been held that printed matter that is not functionally related to an apparatus does not distinguish the claimed apparatus from prior art. Therefore, as Graves et al. teach Applicant's claimed device with a storage identifier (figures 1 and 4), affixing a bar code to the body of said device would have been obvious to one of ordinary skill.

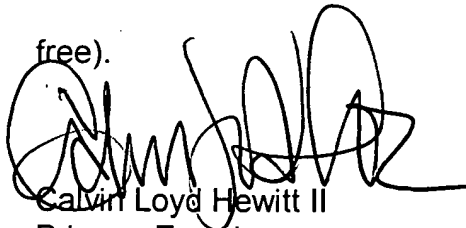
Conclusion

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

November 10, 2006